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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/608,013	06/30/2000	Christopher J. Lasher	103864-1200RI	9950
24395	7590	06/10/2004	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP THE WILLARD OFFICE BUILDING 1455 PENNSYLVANIA AVE, NW WASHINGTON, DC 20004			KIM, EUGENE LEE	
			ART UNIT	PAPER NUMBER
			3721	24

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/608,013

Applicant(s)

LASHER ET AL.

Examiner

Eugene L Kim

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 248 and 266 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4, 6, 16, 18-31, 33-44, 46-59, 61-76, 78-90, 114-115, 118-123, 148-149, 153-162, 164-165 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1-4,6,8-14,16,18-31,33-44,46-59,61-76,78-90,114,115,118-123,148,149,153-162 and 164-218.

DETAILED ACTION

1. Upon allowance of this application, applicant must file a new declaration including a statement of error that is specific enough to encompass all of applicants amendments to this application as set forth in MPEP 1414. The statement of error must cover the changes made in the latest amendment with an "all errors not covered by a previous declaration arose without deceptive intent" statement in the new declaration. Applicant must also surrender the original letters patent before the case can be allowed.
2. The amendment filed on 11/26/2003 has been entered but Claims 7 and 15 have not been entered for failure of complying with 37 CFR 1.173(b).
3. Newly submitted claims 166-218 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims are directed to different species embodiments. Furthermore, the examiner notes that this case overall has created a tremendous burden on the examiner with an unreasonable number of claims which in view of the nature and scope of applicant's invention are repetitious and multiplied, the net result of which is to confuse rather than to clarify the invention. A rejection on undue multiplicity based on 35 USC 112 second paragraph may be appropriate. See MPEP 2173.05(n).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 166-218 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

4. Claims 1-3, 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Charhut in view of Bailer and Goldberg as discussed in paragraph 1 of the last office action.

5. Applicant's arguments filed 11/26/2003 have been fully considered but they are not persuasive. In response to applicants arguments regarding the customized literature packs, the examiner notes that making customized packages are well known in the art as taught by Charhut. In Charhut, each prescription is customized to a particular dosage as well as a customized label that is attached to each particular vial. The actual product being customized is a matter of design choice by the user.

Regarding when the bottle identifiers are applied to the bottles in claim 3 solves no stated problem since the applied prior art applies a label equivalent to applicants. Further the timing of the application of the bottle identifiers would be a matter of design choice within the skill of the art. See in re Kuhle, 188 USPQ 7 (CCPA 1975)

Regarding applicant argument regarding the plurality of bottles in a carrier, the examiner notes that it has been held that it is obvious to one of ordinary skill in the art to duplicate parts for a multiplied effect. See St Regis Paper Co v Bemis Co, Inc, 193 USPQ 8, 11 (7th Cir 1977). Furthermore, it is well known in the art to compartmentalize carriers to separate products being dispensed into carriers.


6. Claims 4, 6, 16, 18-31, 33-44, 46-59, 61-76, 78-90, 114-115, 118-123, 148-149, 153-162, 164-165 are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugene L Kim whose telephone number is 703 308-1886. The examiner can normally be reached on Tuesday-Friday 8 a.m. to 6 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 703 308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Eugene L Kim
Primary Examiner
Art Unit 3721